

Appl. No. : 10/646,071
Filed : August 22, 2003

REMARKS

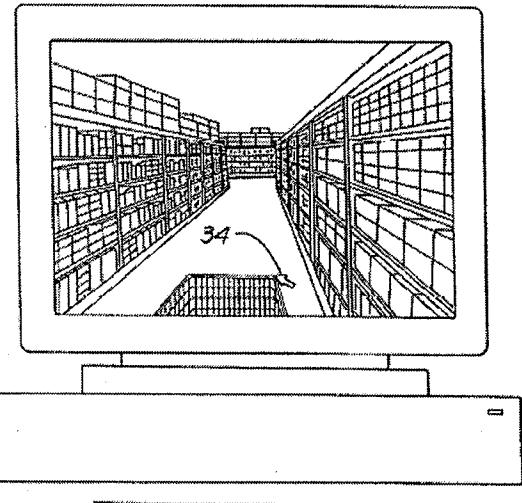
The May 9, 2006 Office Action was based upon pending Claims 1-27. This Amendment amends Claims 1, 8, 11, 17, 22, 23, and 26. Thus, after entry of this Amendment, Claims 1-27 remain pending and are presented for further consideration.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e)

On Page 2 of the Office Action, Claims 1-2 and 5-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kenney (U.S. Patent No. 6,381,583). Applicant respectfully submits that anticipation under 35 U.S.C. 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, (Fed. Cir. 1987); *See also*, M.P.E.P. § 2131. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Additionally, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to support the determination that the inherent characteristic necessarily flows from the teachings of the applied prior art." *See* M.P.E.P. § 2112. In view of the comments below, Applicant respectfully asserts that the pending claims are not anticipated by the cited art and requests removal of all rejections.

Kenney discloses that an "interactive electronic shopping system and method create a virtual shopping facility from an actual shopping facility, such as a grocery store, restaurant, or

office." *Kenney*, Abstract. Thus, Kenney appears to recreate a physical store as a virtual store that is accessible on a computer. Kenney further describes that a "shopper at a computer or other suitable display device can *move through the virtual shopping facility* and see replicas of *what would be seen in moving through the actual shopping facility*." *Id.* (emphasis added). With reference to Figure 4 of Kenney, reproduced



Appl. No. : 10/646,071
Filed : August 22, 2003

to the left, Kenney describes that “traveling through the store involves the programming of one or more of the computers 18, 20 to determine the location of the shopper, access data, and display the retrieved data. . . One way to determine the location of the shopper in the store is via a cursor 34 displayed on the screen as shown in FIG. 4.” *Id.* at col. 9, ll. 34-42. Accordingly, in the Kenney system, a user moves through a virtual store in the same manner as the user would walk through the actual store.

In contrast to Kenney, amended Claim 1 recites “[a] merchandise locating system . . . comprising: a display configured to present a graphical mapped image of an environment where merchandise is used.” Kenney fails to teach or suggest at least this feature. For example, Kenney discloses that a “virtual shopping facility” is displayed to the user, rather than an “image of an environment where merchandise is used,” as recited in Claim 1.

Furthermore, Kenney fails to teach or suggest “a user accessible computer . . . configured to determine a portion of the graphical mapped image corresponding to the user input and to control the display to present a lower level graphical image of the environment where merchandise is used corresponding to the determined portion of the graphical mapped image,” as recited in Claim 1. In contrast, Kenney discloses that “[w]hen the shopper stops at a particular section to look at a product, as indicated by left, right, forward or reverse motion such as input through the arrow keys of the keyboard, a more limited, closer view of a section of the aisle can be viewed.” *Kenney*, col. 10, ll. 5-17. Thus, the Kenney system shows a consumer a “closer view of a section of the aisle,” but Kenney fails to teach or suggest that a display illustrates “a lower level graphical image of the *environment where merchandise is used* corresponding to the determined portion of the graphical mapped image,” as recited in Claim 1. Thus, the operation of the Kenney system and Claim 1 are fundamentally different, as the Kenney system provides the user with a virtual store view, while Claim 1 recites a system wherein images of an environment where merchandise is used are displayed to the user. In the system of Claim 1, after the user has drilled down through images of the location where merchandise is used, such as images of a residential lot (see, e.g., paragraph [0049]), the “user accessible computer . . . determine[s] a location in a store of the desired merchandise item.” Thus, the system recited in Claim 1 displays an “image of an *environment where merchandise is used*,” displays “a lower level graphical image of the *environment where merchandise is used*,” “receive[s] an input . . . indicating a user

Appl. No. : 10/646,071
Filed : August 22, 2003

selected portion of the lower level graphical image corresponding to a particular desired merchandise item," and then "determine[s] a location *in a store* of the desired merchandise item." Accordingly, Claim 1 recites a system wherein multiple views of an "environment where merchandise is used" are first displayed to a user and then the computer determines a location of a desired merchandise item in a store. Kenney, on the other hand, is directed only to displaying images of a "virtual shopping facility." For at least the reasons discussed above, Applicant asserts that Claim 1 is in condition for allowance over the cited art.

Claims 2-7 depend from Claim 1 and, therefore, include each of the limitations of Claim 1. Thus, Claims 2-7 are believed to be allowable over the cited art at least for the reasons discussed above with reference to Claim 1. Reconsideration of Claims 1-7 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

On page 4 of the Office Action, Claims 3-4 and 8-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Hoffman (U.S. Patent Application Publication No. 2002/0178013). Applicant respectfully request this rejection be withdrawn for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. The Federal circuit has held that "[t]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. [...] virtually all [inventions] are combinations of old elements. [internal quotes omitted...] If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). In view of the remarks below, Applicant respectfully maintains that the pending claims are each allowable over the cited art.

Appl. No. : 10/646,071
Filed : August 22, 2003

Hoffman is directed towards a “customer guidance system for retail store.” *Hoffman*, Title. In Hoffman, a “customer enters a product code indicative of the product in which the customer is interested. The system then retrieves product location information for the product. The retrieved product location information is presented to the customer.” Id. at Abstract. Thus, Hoffman appears to teach a system for providing consumers with the location of a product within a store, wherein the product is identified by the customer using a product code.

Claim 8 recites, in pertinent part, a “system of locating merchandise in a store comprising a plurality of merchandise items, the system comprising: means for displaying a graphical mapped image of an environment where at least some of the plurality of merchandise items are used.” The cited art fails to teach or suggest this feature. For example, Kenney describes “a virtual shopping facility” wherein the “shopper at a computer or other suitable display device can *move through the virtual shopping facility* and see replicas of *what would be seen in moving through the actual shopping facility.*” Kenney, Abstract (emphasis added). In contrast, Claim 8 recites a means for displaying a graphical image of an “environment where at least some of the plurality of merchandise items are used.” Thus, while Claim 8 displays images of an environment where merchandise items are used, Kenney discloses that the images are of the store in which the merchandise items may be purchased. There is no teaching or suggestion in Kenney of displaying a graphical image of an “environment where at least some of the plurality of merchandise items are used,” as recited in Claim 8.

The combination of Hoffman with Kenney also fails to teach or suggest at least the feature of displaying a graphical image of an “environment where at least some of the plurality of merchandise items are used,” as recited in Claim 8. Hoffman describes a “method of guiding a customer to a product available for sale in a retail store.” *Hoffman*, para. [0006]. Thus, Hoffman appears to describe a system that determines where merchandise items are located in a store, rather than displaying a graphical image of an “environment where at least some of the plurality of merchandise items are used,” as recited in Claim 8. Accordingly, there is no teaching or suggestion in Hoffman of displaying a graphical image of an “environment where at least some of the plurality of merchandise items are used,” as recited in Claim 8.

Amended Claim 11 recites a “method for locating merchandise located in a store, the method comprising: displaying a graphical mapped image of a merchandise environment,

wherein the merchandise environment does not comprise the store.” The cited art fails to teach or suggest the display of a “merchandise environment [that] does not comprise the store,” as recited in Claim 11. Amended Claim 17 recites a “method of selecting of graphically locating merchandise available in a stored ... comprising: displaying a first graphical mapped image ... depicting an environment where at least some of the merchandise is located after purchase by a consumer.” The cited art fails to teach or suggest the display of “an environment where at least some of the merchandise is positioned after purchase of the merchandise by a consumer,” as recited in Claim 17. Amended Claim 22 recites a “method comprising ... displaying a first graphical mapped image on a display, the first graphical mapped image ... depicting an environment remote from a store that sells the merchandise.” The cited art fails to teach or suggest the display of “an environment remote from a store that sells the merchandise,” as recited in Claim 22. Amended Claim 23 recites a “method of graphically identifying merchandise ... comprising: displaying a first graphical mapped image of a merchandise environment on a display, the merchandise environment comprising an environment remote to a store.” The cited art fails to teach or suggest the display of a “merchandise environment comprising an environment remote to a store,” as recited in Claim 23. Amended Claim 26 recites a “method of graphically identifying merchandise, the method comprising: displaying a residential lot image depicting at least a residence, the residential lot image comprising one or more lower level merchandise environments.” The cited art fails to teach or suggest the display of “a residential lot image depicting at least a residence,” as recited in Claim 26.

In contrast to the above noted recitations from Claims 11, 17, 22, 23, and 26, Kenney describes “a virtual shopping facility” wherein the “shopper at a computer or other suitable display device can *move through the virtual shopping facility* and see replicas of *what would be seen in moving through the actual shopping facility*.” *Kenney*, Abstract (emphasis added). Thus Kenney fails to teach or suggest at least the above-cited features of these claims. The combination of Hoffman with Kenney does not remedy the deficiency of Kenney. Hoffman describes, for example, that a “customer enters a product code indicative of the product in which the customer is interested. The system then retrieves product location information for the product. The retrieved product location information is presented to the customer.” *Hoffman*, at Abstract. “The product location information may take the form of a map of the retail store in

Appl. No. : 10/646,071
Filed : August 22, 2003

question, with the map having highlighted notations to indicate the locations of the products within the store.” *Id.*, para. [0025]. Thus, Hoffman describes a “map of the retail store” and Kenney describes a “virtual shopping facility,” rather than the display of a “merchandise environment [that] does not comprise the store,” as recited in Claim 11, “an environment where at least some of the merchandise is located after purchase by a consumer,” as recited in Claim 17, “an environment remote from a store that sells the merchandise,” as recited in Claim 22, a “merchandise environment comprising an environment remote to a store,” as recited in Claim 23, or “a residential lot image depicting at least a residence,” as recited in Claim 27. Accordingly, the cited art, alone and in combination, fails to teach or suggest at least these elements of Claims 11, 17, 22, 23, and 26.

Certain features of each pending independent claim have been discussed above. However, the discussed features are only a limited representation of the features that are believed to be patentable over the cited art. Furthermore, because a rejection under 35 U.S.C. §102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” and a rejection under 35 U.S.C. § 103 similarly requires that the references when combined teach or suggest all of the claim limitations, Applicant further asserts that the combinations of features in each claim are patentable over the cited art. *Verdegaal; M.P.E.P. § 2143.*

Claims 9-10 depend from Claim 8; Claims 12-16 depend from Claim 11; Claims 18-21 depend from Claim 17; Claims 24-25 depend from Claim 23; and Claim 27 depends from Claim 26. The dependent claims include each of the limitations of their respective base claims and are, therefore, believed to be allowable over the cited art at least for the reasons discussed above with reference to their respective based claims. Reconsideration of Claims 8-27 is respectfully requested.

Appl. No. : 10/646,071
Filed : August 22, 2003

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/8/06

By: Russell M. Jeide
Russell M. Jeide
Registration No. 54,198
Attorney of Record
Customer No. 20,995
(951) 781-9231

R:\DOCS\RMJ\RMJ-5045.DOC:lw
080106